

DOCKET NO.: ISIS-4947  
Application No.: 10/071,822  
Office Action Dated: January 30, 2004

PATENT

### REMARKS/ARGUMENTS

Claims 26 and 27 are pending. Claims 1-25 and 28 were previously canceled without prejudice to their presentation in another application.

Claims 26 and 27 stand rejected under 35 U.S.C. § 102(a) as allegedly anticipated by PCT Patent Application No. WO 98/49348 ("the Dean application"). Applicants request reconsideration of this rejection because the disclosure of the Dean application is too broad to be anticipatory. The Dean application discloses certain modified oligonucleotides which are formulated according to methods known in the art (see, for example, page 3, lines 7-15 and page 4, lines 18-19). Such formulations may include many possible ingredients as detailed on page 19, line 5 to page 23, line 14 of the Dean application. The claims now recite a specific composition comprising a plurality of carrier particles, an oligonucleotide and capric acid. As discussed in a previous response, this specific combination could only be produced by picking and choosing from the large number of possibilities taught by Dean. This is inconsistent with a rejection for anticipation as found in *In re Schaumann*. Therefore, the rejection is improper and should be withdrawn.

Claims 26 and 27 stand rejected under 35 U.S.C. § 102(a) as allegedly anticipated by PCT Patent Application No. WO 97/25339 ("the Lockett application"). Applicants traverse the rejection. As with the rejection based on the Dean application, the rejection based on the Lockett application is based on picking and choosing among the possible compositions disclosed in the Lockett application (see, for example, page 2, line 5 to page 3, line 11 and page 8, line 20 to page 13, line 23). Because such picking and choosing is inconsistent with anticipation, Applicants respectfully request reconsideration and withdrawal of the rejection.

### FEES

The Applicants hereby authorize the Commissioner to charge \$905 to the Deposit Account 50-0252 for an extension of three months in time of response, small entity (\$510) and a request for continued examination, small entity (\$395). It is believed that there are no additional fees due. However, if an additional fee is due, the Commissioner is hereby authorized to charge the appropriate amount to the above named Deposit Account.

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### CONCLUSIONS

Applicant believes that the foregoing is a full and complete response to the Office Action of record. Accordingly, an early and favorable reconsideration of the rejections and allowance of all of pending claims 26 and 27 is respectfully requested.

Respectfully submitted,

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